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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,113	08/15/2001	James E. King	5681-04100	9999
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B. Noel Kivlin Conley, Rose, & Tayon, P.C. P.O. Box 398 Austin, TX 78767			EXAMINER POPHAM, JEFFREY D	
			ART UNIT 2137	PAPER NUMBER

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,113

Applicant(s)

KING ET AL.

Examiner

Jeffrey D. Popham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Remarks

Claims 1-31 are pending.

1. Included is an official translation of Merrien (PCT No. WO9857474), translated by the Ralph McElroy translation company, which will be used in place of the machine-translation provided in the last action for the sake of clarity. The referenced sections for the 35 U.S.C. 103 rejections are the same as in the last action, but refer to this official translation as opposed to the machine translated version.

Response to Arguments

2. Applicant's arguments filed 11/2/2005 have been fully considered but they are not persuasive.

Applicants argue that the motivation used to combine Walters with Merrien ("to verify that the card input to the system was an approved card that could be used with the system") is not found within the cited references. This motivation is, indeed, found in Walters. Column 2, lines 31-35 describe how only the proper (approved) memory card can be used for a particular application. Column 2, line 60 to Column 3, line 3 describe how it is verified that the card is an approved card that can be used with the system, as does the cited section (Column 4, line 62 to Column 5, line 51).

Applicants argue that the protection code of Waters is strictly for internal use, and that making this protection code public would teach away from Merrien.

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The examiner fully admits that the protection code of Walters is strictly for internal use ("the protection code does not supply any information which is used outside of the authorization procedure"). Within the combination, the card is first authorized by using the write-then-read method of Walters. Only then, can other data be accessed on the card. This other data comprises the network identity of Merrien. Merrien discloses that data will only be read from (or written to) the card after access conditions have been met via use of a cryptographic code (protection code of Walters) and authentication of the card (Page 10, lines 16-28). Once the card has been appropriately authenticated and authorized, the network identity can be read from the card.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 10, 13, 15, 20, 23, 25, 26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien (PCT No. WO9857474) in view of Walters (U.S. Patent 5,357,573).

Regarding Claim 1,

Merrien discloses a processing unit connectable to a data communications network, the processing unit having a device

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reader (Page 8, line 34 to Page 9, line 4) for a portable storage device that includes storage operable to supply a network identity (Page 9, lines 18-23) for the processing unit and an access controller (Page 10, lines 16-28), the access controller being operable to prevent unauthorized reading and writing to the storage (Page 10, lines 16-28), the processing unit being operable to read the supplied network identity only after authentication has taken place (Page 10, lines 16-28). Merrien does not disclose the method of first attempting to write to the storage device and, only once the write has failed, to read the network identity.

Walters, however, discloses that the processing unit is operable, before reading from the portable storage device, to attempt a write to the portable storage device, and, on determining that the write has failed, to read a protection code, authorizing the reading of data on the card (Column 4, line 62 to Column 5, line 51). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the memory card of Walters into the smart card system of Merrien in order to verify that the card input to the system was an approved card that could be used with the system.

Regarding Claim 10,

Claim 10 is a program claim that corresponds to system claim 1 and is rejected for the same reasons.

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Regarding Claim 15,

Claim 15 is a program on carrier medium claim that corresponds to system claim 1 and is rejected for the same reasons.

Regarding Claim 20,

Claim 20 is a method claim that corresponds to system claim 1 and is rejected for the same reasons.

Regarding Claim 25,

Claim 25 is a system claim that is broader than system claim 1 and is rejected for the same reasons.

Regarding Claim 26,

Claim 26 is a system claim that is broader than system claim 1 and is rejected for the same reasons.

Regarding Claim 4,

Merrien as modified by Walters discloses the system of claim 1, in addition, Merrien discloses that the portable storage device is a smart card (Page 8, line 34 to Page 9, line 4), the access controller is a microcontroller (Page 12, lines 5-14), and the device reader is a smart card reader (Page 8, line 34 to Page 9, line 4; and Page 9, line 24 to Page 10, line 2).

Regarding Claim 13,

Claim 13 is a program claim that corresponds to system claim 4 and is rejected for the same reasons.

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Regarding Claim 23,

Claim 23 is a method claim that corresponds to system claim 4 and is rejected for the same reasons.

Regarding Claim 30,

Claim 30 is a system claim that is broader than system claim 4 and is rejected for the same reasons.

Regarding Claim 29,

Merrien as modified by Walters discloses the device of claim 25, in addition, Merrien discloses that the access controller is a microcontroller (Page 12, lines 5-14).

4. Claims 2, 11, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Braithwaite (U.S. Patent 5,644,444).

Regarding Claim 2,

Merrien as modified by Walters discloses the system of claim 1, in addition, Merrien discloses copying the supplied network identity from a data carrier to a second memory location and to use the supplied network identity (Page 9, lines 18-23; and Page 10, lines 16-28). Walters discloses attempting a write to the storage of the portable storage device, and on determining that the write has failed, to copy data from the portable storage device (Column 4, line 62 to Column 5, line 21). Merrien as modified by Walters does

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not disclose the detection of a portable storage device upon powering up of the processing unit.

Braithwaite, however, discloses that the processing unit is operable, on being powered up, to determine whether a said portable storage device is present in the device reader (Column 9, lines 30-41). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the write protection scheme of Braithwaite into the smart card system of Merrien as modified by Walters in order to properly detect a portable storage device so as to continue operations without delay.

Regarding Claim 11,

Claim 11 is a program claim that corresponds to system claim 2 and is rejected for the same reasons.

Regarding Claim 21,

Claim 21 is a method claim that corresponds to system claim 2 and is rejected for the same reasons.

5. Claims 3, 12, 22, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Hellman (U.S. Patent 4,200,770).

Regarding Claim 3,

Merrien as modified by Walters discloses the system of claim 1, in addition, Merrien discloses that the processing unit is

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operable to modify content of the portable storage device on the condition that proper authentication and encryption have taken place (Page 10, lines 16-28), but Merrien as modified by Walters does not disclose key exchange or key-to-key encryption.

Hellman, however, discloses key-to-key encryption (Column 8, line 65 to Column 9, line 25) and a key exchange method comprising a transmitter that supplies a key to a receiver (Column 9, lines 7-8), and, in response to receipt of a return key from the receiver (Column 9, lines 9-10), to send an encrypted message to the receiver (Column 9, lines 20-23). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the key exchange and encryption schemes of Hellman into the smart card system of Merrien as modified by Walters because Merrien discloses that any convenient or conventional encryption scheme may be used in the system (the techniques of Diffie and Hellman being quite well known at the time the invention was made) (Merrien, Page 18, line 26 to Page 19, line 22).

Regarding Claim 12,

Claim 12 is a program claim that corresponds to system claim 3 and is rejected for the same reasons.

Regarding Claim 22,

Claim 22 is a method claim that corresponds to system claim 3 and is rejected for the same reasons.

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Regarding Claim 27,

Claim 27 is a system claim that is broader than system claim 3 and is rejected for the same reasons.

Regarding Claim 28,

Merrien as modified by Walters and Hellman discloses the system of claim 27, in addition, Merrien discloses that the access controller is subsequently operable to respond to an encrypted command from the processing unit to modify the content of the storage in the portable storage device (Page 10, lines 16-28).

6. Claims 5, 14, 24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Windows NT Server (MacDonald, D., "Windows NT Server, Microsoft Windows NT 5.0 TCP/IP Implementation Details TCP/IP Protocol Stack and Services", 10/1998, obtained from <http://asg.web.cmu.edu/orpheus/msdocs/wp/nt5tcpip.doc>).

Regarding Claim 5,

Merrien as modified by Walters does not disclose a MAC address.

Windows NT Server, however, discloses that the network identity comprises a MAC address (Page 12, Paragraphs 2 and 3). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the ARP protocol of Windows NT Server into the smart card system of Merrien as

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modified by Walters in order to obtain a (physical) MAC address of a computer from the (logical) IP address of that computer.

Regarding Claim 14,

Claim 14 is a program claim that corresponds to system claim 5 and is rejected for the same reasons.

Regarding Claim 24,

Claim 24 is a method claim that corresponds to system claim 5 and is rejected for the same reasons.

Regarding Claim 31,

Claim 31 is a system claim that is broader than system claim 5 and is rejected for the same reasons.

7. Claims 6, 7 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Combaluzier (U.S. Patent 5,973,475).

Regarding Claim 6,

Merrien as modified by Walters discloses the system of claim 1, in addition, Merrien discloses that the processing unit comprises circuitry to allow the processing unit to control functions of the processing unit (Page 9, lines 11-17), but does not disclose that the circuitry is a service processor.

Combaluzier, however, discloses that the processing unit comprises a service processor, the service processor being

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programmed to control reading of the portable storage device (Column 4, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the cellular telephone of Combaluzier into the smart card system of Merrien as modified by Walters in order to identify the user and authorize the use of the cellular telephone, as well as perform any needed transferring of data between the portable storage device and the processing unit (Column 4, lines 34-55).

Regarding Claim 16,

Claim 16 is a program claim that corresponds to system claim 6 and is rejected for the same reasons.

Regarding Claim 7,

Merrien as modified by Walters and Combaluzier discloses the system of claim 6, in addition, Combaluzier discloses that the service processor is a microcontroller (Column 4, lines 22-33).

Regarding Claim 17,

Claim 17 is a program claim that corresponds to system claim 7 and is rejected for the same reasons.

Regarding Claim 18,

Merrien as modified by Walters discloses the program of claim 10, but does not disclose that this program is run on a microcontroller.

Combaluzier, however, discloses that the microcontroller controls the operations of the processing unit (Column 4, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the cellular telephone of Combaluzier into the smart card system of Merrien as modified by Walters in order to identify the user and authorize the use of the cellular telephone, as well as perform any needed transferring of data between the portable storage device and the processing unit (Column 4, lines 34-55).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Teppler (U.S. Patent 6,792,536).

Merrien as modified by Walters does not disclose that the processing unit is a server computer.

Teppler, however, discloses that the processing unit is a server computer (Column 14, lines 32-37; and Column 20, lines 7-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the smart card system of Teppler into the smart card system of Merrien as modified by Walters in order to provide much interoperability and to ensure that secure messaging is done within a protected server security perimeter.

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9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Hastings (U.S. Patent 5,460,441).

Merrien as modified by Walters does not disclose that the processing unit is a rack mountable computer server.

Hastings, however, discloses that the processing unit is a rack mountable computer server (Column 3, line 48 to Column 4, line 17). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the server rack system of Hastings into the smart card system of Merrien as modified by Walters in order to have the server(s) disposed in a unique manner so as to provide substantially improved access thereto.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters and Combaluzier, further in view of Teppler.

Merrien as modified by Walters and Combaluzier discloses the microcontroller comprising a control program as in claim 18, in addition, Combaluzier discloses that the microcontroller is operable as a service processor and connected to read the content of storage in a portable storage device mounted in the portable storage device (Column 4, lines 22-33). Merrien as modified by Walters and Combaluzier does not disclose that the processing unit is a server computer.

Teppler, however, discloses that the processing unit is a server computer (Column 14, lines 32-37; and Column 20, lines 7-18). It would

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have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the smart card system of Teppler into the smart card system of Merrien as modified by Walters and Combaluzier in order to provide much interoperability and to ensure that secure messaging is done within a protected server security perimeter.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey D Popham
Examiner
Art Unit 2137


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER